



ORIGINAL

Docket No. T2315-907789

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IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS & INTERFERENCES

Appellant: Raymond J. BERGERON, JR. :
Serial No.: 10/091,591 : Art Unit: 1614
Filed: March 07, 2002 : Examiner: Rebecca Cook
For: Method and Composition for the Treatment :
of Diarrhea and Gastrointestinal Spasms

REPLY BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 CFR §1.193, appellant replies to the Examiner's Answer dated August 7, 2003.

The Examiner states at Page 3, 3d full paragraph of the Examiner's Answer:

“--- ‘533 discloses compositions (column 3, lines 59-60) comprising the instant compound (column 4, Table 1, compounds 33 and 34) and that they are used to treat diarrhea---”

As pointed out in the Brief, however, such is not the case. Although compounds 33 and 34 of Table 1 of the reference are encompassed by the claims on appeal, the reference does not disclose that they can be “used for the treatment of diarrhea”. Table 1 of the reference merely sets forth K_i values of a series of polyamines. Nowhere in the reference is it stated, inferred or implied that the polyamines listed are useful for the treatment of diarrhea. At column 19, lines 27-58, it is disclosed that, based on the tabulations in Table 1, certain assumptions can be made concerning the “protonation states” of the polyamines, nothing more. Although it is disclosed that all of the polyamines tabulated were “screened for their 48 and 96 hour IC_{50} ”

values in L1210 cell culture assays, there is certainly nothing therein that can be construed as a disclosure of the use of compounds 33 and 34 for treating diarrhea.

In the paragraph bridging pages 3 and 4 of the Answer, the Examiner states:

“---Appellant argues that the only pharmaceutical compositions for the treatment of diarrhea disclosed by ‘533 contain at least one CH(OH) group in at least one of the bridging groups. He further argues that he is not claiming a pharmaceutical composition for the treatment of diarrhea containing a polyamine which contains at least one CH(OH) group in at least one of the bridging groups---”.

The Examiner goes on to state in the first full paragraph of page 4:

“---This is not persuasive. Instant claim 1 recites a ‘---composition comprising--- an effective amount of a compound---’. The instant comprising language is open-ended and does not exclude the CH(OH) group of ‘533---”.

However, the so-called “comprising language” does not modify the definition of the active anti-diarrheal, i.e., the polyamine. The language of the claim defining the polyamine is the structural formula (I) of claim 1 which, when read in conjunction with the “wherein” clause appearing immediately thereafter, obviously excludes the CH(OH) group containing polyamines disclosed by ‘533 to be useful for the treatment of diarrhea.

The “comprising language” of the claims does not relieve the Examiner of the necessity for citing a reference that discloses at least one of the polyamines embraced by the structural formula (I) and that it is useful for the treatment of diarrhea if a valid rejection of the claims over prior art is the objective.

Since a reference must disclose each and every element set forth in the claim to satisfy the requirements of 35 USC §102 (See *In re Brown*, 141 USPQ 166), the ‘533 reference clearly does not anticipate the claimed invention.

The Examiner states in the 3d full paragraph of page 4:

“---Appellant argues that while compounds 33 and 34 are embraced by the structural formulae of the rejected claims, there is no disclosure in the reference of pharmaceutical compositions suitable for the treatment of diarrhea that contains either compound 33 or 34. This is not persuasive. ---

5,962,533 discloses (column 3, lines 59-60) that the compounds listed within can be used in pharmaceutical compositions. The fact that compounds 33 and 34 are not disclosed as having anti-diarrheal properties does not remove them as references. It is well-established that intended use does not impart patentability in a composition claim---".

The precise wording of the disclosure at col. 3, lines 58-61 is as follows:

“---It is another object of the invention to provide novel pharmaceutical compositions and methods of treating human and non-human animals with the novel polyamine derivatives---”.

Obviously, the Examiner has overstated the disclosure of this portion of the '533 reference.

The language misquoted by the Examiner cannot be interpreted as equivalent to a disclosure that all of the “compounds listed within can be used in pharmaceutical compositions”. In any event, this portion of the reference certainly cannot be interpreted as a disclosure that all of the “compounds listed within” can be used in anti-diarrheal pharmaceutical compositions.

Moreover, the Examiner's contention that “intended use cannot impart patentability to composition claim” is not does not apply to the present fact situation.

Conclusion

For the reasons set forth herein and in the Brief on Appeal, a reversal of the Final Rejection of record and a remand of the application to the Examiner for immediate allowance are respectfully requested.

Respectfully submitted,

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